

ESTTA Tracking number: **ESTTA480441**

Filing date: **06/27/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Nintendo of America Inc.
Granted to Date of previous extension	06/27/2012
Address	4600 150th Avenue NE Redmond, WA 98052 UNITED STATES
Correspondence information	Nishan Kottahachchi Cooley LLP 777 6th Street, NW Washington, DC 20001 UNITED STATES nkottahachchi@cooley.com, jcrittenden@cooley.com, vvaughan@cooley.com, dmercado@cooley.com, trademarks@cooley.com Phone:202.842.7886

Applicant Information

Application No	85279866	Publication date	02/28/2012
Opposition Filing Date	06/27/2012	Opposition Period Ends	06/27/2012
Applicant	Hyperkin Inc. 1918 Frank Stiles Street South El Monte, CA 91733 UNITED STATES		


Goods/Services Affected by Opposition


Class 009. All goods and services in the class are opposed, namely: Portable video game system, namely, video game machines for use with an external display screen or monitor and video game joysticks
Class 028. All goods and services in the class are opposed, namely: Portable video game system, namely, hand held units for playing video games other than those adapted for use with an external display screen or monitor

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4126556	Application Date	01/18/2011
Registration Date	04/10/2012	Foreign Priority Date	NONE
Word Mark	GAME BOY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1989/06/02 First Use In Commerce: 1989/06/03 Downloadable multimedia files, namely, video games; downloadable electronic game programs; downloadable electronic game software; electronic game programs; electronic game software; video game programs; video game software		

U.S. Registration No.	4158645	Application Date	01/31/2011
Registration Date	06/12/2012	Foreign Priority Date	NONE
Word Mark	GAME BOY COLOR		
Design Mark			
Description of Mark	The mark consists of the words "GAME BOY COLOR" in stylized letters.		
Goods/Services	Class 009. First use: First Use: 1998/05/17 First Use In Commerce: 1998/05/17 Downloadable multimedia files, namely, video games; downloadable electronic game programs; downloadable electronic game software; electronic game programs; electronic game software; video game programs; video game software		

U.S. Registration No.	2550938	Application Date	09/02/1999
Registration Date	03/19/2002	Foreign Priority Date	NONE
Word Mark	GAME BOY ADVANCE		

Design Mark	GAME BOY ADVANCE
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2001/05/17 First Use In Commerce: 2001/05/17 computer game programs; computer game software; [video game machine accessories, namely, carry cases;] and video game software

U.S. Registration No.	2665095	Application Date	09/02/1999
Registration Date	12/24/2002	Foreign Priority Date	NONE
Word Mark	GAME BOY ADVANCE		
Design Mark	GAME BOY ADVANCE		
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 2001/05/17 First Use In Commerce: 2001/05/17 HAND-HELD UNITS FOR PLAYING VIDEO GAMES; CONNECTORS TO CONNECT HAND-HELD VIDEO GAME UNITS WITH OTHER VIDEO GAME MACHINES[, AND CARRY CASES FOR CARRYING HAND-HELD UNITS FOR PLAYING VIDEO GAMES]		

Attachments	85220424#TMSN.jpeg (1 page)(bytes) 85230048#TMSN.jpeg (1 page)(bytes) 75981744#TMSN.gif (1 page)(bytes) 75982105#TMSN.gif (1 page)(bytes) Notice of Opposition.SUPABOY PORTABLE VIDEO GAME SYSTEM.pdf (13 pages)(428379 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by USPS Express Mail Post Office to Addressee on this date.

Signature	/Nishan Kottahachchi/
Name	Nishan Kottahachchi
Date	06/27/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of

Hyperkin Inc.

Serial No.: 85/279,866

Filed: March 29, 2011

Mark: SUPABOY PORTABLE
VIDEO GAME SYSTEM
(stylized)

NOTICE OF OPPOSITION

Opposer Nintendo of America Inc., a Washington corporation having its principal place of business at 4600 150th Avenue NE, Redmond, WA 98052 (“Opposer”), believes it will be damaged by registration of the pending application for the mark SUPABOY PORTABLE VIDEO GAME SYSTEM (stylized) (Serial No. 85/279,866) (“Applicant’s Mark”) in International Classes 9 and 28 (the “Application”), filed on March 29, 2011 by Hyperkin Inc. (“Applicant”) and opposes the registration of Applicant’s Mark. As grounds for its opposition, Opposer alleges the following:

1. Opposer is now, and has been for many years, engaged in the interactive entertainment industry, namely in the distribution and sale of video games and video game units, including electronic game hardware, software, and accessories and merchandise therefor.

2. Since long prior to the filing of the Application, Opposer has used the trademarks GAME BOY, GAME BOY COLOR, and GAME BOY ADVANCE (collectively, “Opposer’s Marks”) in connection with the distribution and sale of electronic video games and video game

units, including hand-held units for playing electronic and video games, electronic game hardware, software, and accessories therefor.

3. Opposer's Marks are inherently distinctive and strong marks that are associated with Opposer.

4. Opposer owns the following U.S. trademark registrations in International Class 9, each of which is valid and subsisting.¹

- GAME BOY, Registration No. 4,126,556, filed on January 18, 2011 and registered on April 10, 2012;
- GAME BOY COLOR (stylized), Registration No. 4,158,645, filed on January 31, 2011 and registered on June 12, 2012; and
- GAME BOY ADVANCE, Registration No. 2,550,938, filed on September 2, 1999 and registered on March 19, 2002.

5. Opposer also owns the following U.S. trademark registration in International Class 28, which is valid and subsisting.²

- GAME BOY ADVANCE, Registration No. 2,665,095, filed on September 2, 1999 and registered on December 24, 2002.

6. Opposer is also the owner of the historic and famous SUPER NINTENDO ENTERTAINMENT SYSTEM mark. Opposer owns a U.S. trademark registration for SUPER NINTENDO ENTERTAINMENT SYSTEM (Registration No. 1693331) covering "game equipment, namely, electronic game programs," in International Class 28, which was filed on March 18, 1991 and registered on June 9, 1992. Opposer began using the SUPER NINTENDO ENTERTAINMENT SYSTEM & Design (stylized) logo (pictured below) in U.S. commerce in

¹ Copies of Opposer's U.S. trademark registrations in International Class 9 are attached as Exhibit A.

connection with electronic video games and video game units, electronic video game hardware, software, and accessories therefor at least as early as August 1991.



7. The SUPA component of Applicant's Mark is similar to and meant to bring to mind Opposer's SUPER NINTENDO ENTERTAINMENT SYSTEM marks and falsely suggests that Applicant's product is a variant of Opposer's famous GAME BOY products, which further contributes to the likelihood of confusion and dilution of Opposer's Marks.

8. Opposer's Marks have been promoted extensively by Opposer throughout the United States and the world.

9. Consumers seeing Opposer's Marks recognize them as identifying Opposer as the source of the goods bearing Opposer's Marks.

10. As a result of Opposer's widespread use of Opposer's Marks in the United States and worldwide, extensive advertising and promotion, continuous and unsolicited media coverage, the high degree of consumer recognition of Opposer's Marks, numerous trademark registrations, and the absence of any material use of any highly similar mark by others, Opposer's Marks are famous within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c).

11. Upon information and belief, Applicant is a California corporation with its principal office at 1918 Frank Stiles Street, South El Monte, CA 91733.

² A copy of Opposer's U.S. trademark registration in International Class 28 is attached as Exhibit B.

12. Applicant seeks to register the mark SUPABOY PORTABLE VIDEO GAME SYSTEM (stylized) (pictured below) in connection with “portable video game system, namely, video game machines for use with an external display screen or monitor and video game joysticks” in International Class 9 and “portable video game system, namely, hand held units for playing video games other than those adapted for use with an external display screen or monitor” in International Class 28 (collectively, “Applicant’s Goods”). The Application was filed on March 29, 2011 and published in the Official Gazette of the PTO on February 28, 2012.



13. Applicant’s Mark is highly similar to Opposer’s Marks in appearance, sound, meaning, and commercial impression. Applicant’s Mark is identical to Opposer’s Marks in their dominant component – i.e., the arbitrary and distinctive BOY suffix. Moreover, Applicant has merely added a descriptive word SUPA to the dominant, arbitrary, and distinctive BOY suffix of Opposer’s Marks, and therefore has created a mark that is substantially similar to Opposer’s Marks in their entirety. The stylization and commercial impression of the Applicant’s Mark is also highly similar to Opposer’s SUPER NINTENDO ENTERTAINMENT SYSTEM (stylized) logo (pictured above).

14. Applicant uses Applicant’s Mark in U.S. commerce to identify a hand-held video game player that is designed to play Super Nintendo Entertainment System game cartridges and Japanese Super Famicom game cartridges.

15. Upon information and belief, the goods Applicant offers under Applicant's Mark are offered through the same or similar channels of trade as the goods offered in connection with Opposer's Marks.

16. Upon information and belief, Applicant selected Applicant's Mark with knowledge of and intent to cause confusion with Opposer's Marks and falsely imply an association with or sponsorship by Opposer. Such information and belief is based, in part, upon Applicant's selection of a mark that closely resembles Opposer's Marks well after Opposer's Marks already had become famous, and upon the similarities between the goods Applicant offers in connection with Applicant's Mark and those offered in connection Opposer's Marks.

17. Opposer is not affiliated or connected with Applicant or the goods it offers and Opposer has not consented to Applicant's use or attempt to register Applicant's Mark.

18. There is no issue as to priority of use. Opposer began using Opposer's Marks, and enjoys priority as a result of the filing dates of its trademark registrations, well prior to the filing date of the Application for the Applicant's Mark. Furthermore, Opposer's Marks became famous well before the filing date of the Application for the Applicant's Mark.

19. Applicant's use of the SUPABOY PORTABLE VIDEO GAME SYSTEM (stylized) mark in connection with "portable video game system, namely, video game machines for use with an external display screen or monitor and video game joysticks" in International Class 9 and "portable video game system, namely, hand held units for playing video games other than those adapted for use with an external display screen or monitor" in International Class 28 is likely to confuse the public as to the source and origin of Applicant's Goods and/or falsely suggests an association, connection, sponsorship, or relationship between Opposer and Applicant.

20. Applicant's use of the SUPABOY PORTABLE VIDEO GAME SYSTEM (stylized) mark in connection with "portable video game system, namely, video game machines for use with an external display screen or monitor and video game joysticks" in International Class 9 and "portable video game system, namely, hand held units for playing video games other than those adapted for use with an external display screen or monitor" in International Class 28 is likely to cause dilution of the distinctive quality of Opposer's Marks.

WHEREFORE, Opposer believes it will be damaged by the registration of Applicant's Mark in International Class 9 and International Class 28 and requests that the Board deny registration of Applicant's Mark pursuant to Sections 2, 13, and 43 of the Lanham Act, 15 U.S.C. §§1052, 1063, and 1125.

Respectfully submitted,

COOLEY LLP

By:


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Attorneys for Opposer Nintendo of America Inc.

Date: June 27, 2012

CERTIFICATE OF SERVICE

I hereby certify that on June 27, 2012, a true and correct copy of the foregoing
NOTICE OF OPPOSITION has been served by mailing said copy via U.S. mail, postage
prepaid, addressed to:

Edward C. Schewe
Schewe and Associates
1600 Rosecrans Ave, 4th Floor
Manhattan Beach, CA 90266

Attorney of Record for Applicant Hyperkin Inc.


Vicki Vaughan

EXHIBIT A

United States of America

United States Patent and Trademark Office

GAME BOY

Reg. No. 4,126,556

Registered Apr. 10, 2012

Int. Cl.: 9

TRADEMARK

PRINCIPAL REGISTER

NINTENDO OF AMERICA INC. (WASHINGTON CORPORATION)
4600 150TH AVENUE NE
REDMOND, WA 98052

FOR: DOWNLOADABLE MULTIMEDIA FILES, NAMELY, VIDEO GAMES; DOWNLOADABLE ELECTRONIC GAME PROGRAMS; DOWNLOADABLE ELECTRONIC GAME SOFTWARE; ELECTRONIC GAME PROGRAMS; ELECTRONIC GAME SOFTWARE; VIDEO GAME PROGRAMS; VIDEO GAME SOFTWARE, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 6-2-1989; IN COMMERCE 6-3-1989.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 2,404,601, 2,550,938, AND 2,974,450.

SN 85-220,424, FILED 1-18-2011.

JANICE L. MCMORROW, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office

United States of America

United States Patent and Trademark Office

GAME BOY COLOR

Reg. No. 4,158,645

Registered June 12, 2012

Int. Cl.: 9

TRADEMARK

PRINCIPAL REGISTER

NINTENDO OF AMERICA INC. (WASHINGTON CORPORATION)
4600 150TH AVENUE NE
REDMOND, WA 98052

FOR: DOWNLOADABLE MULTIMEDIA FILES, NAMELY, VIDEO GAMES; DOWNLOADABLE ELECTRONIC GAME PROGRAMS; DOWNLOADABLE ELECTRONIC GAME SOFTWARE; ELECTRONIC GAME PROGRAMS; ELECTRONIC GAME SOFTWARE; VIDEO GAME PROGRAMS; VIDEO GAME SOFTWARE, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 5-17-1998; IN COMMERCE 5-17-1998.

OWNER OF U.S. REG. NOS. 1,622,675, 2,404,601, AND OTHERS.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "COLOR", APART FROM THE MARK AS SHOWN.

THE MARK CONSISTS OF THE WORDS "GAME BOY COLOR" IN STYLIZED LETTERS.

SN 85-230,048, FILED 1-31-2011.

JANICE L. MCMORROW, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

Reg. No. 2,550,938

United States Patent and Trademark Office

Registered Mar. 19, 2002

**TRADEMARK
PRINCIPAL REGISTER**

GAME BOY ADVANCE

NINTENDO OF AMERICA INC. (WASHINGTON
CORPORATION)
4820 - 150TH N.E.
REDMOND, WA 98052

VIDEO GAME SOFTWARE , IN CLASS 9 (U.S. CLS.
21, 23, 26, 36 AND 38).

FIRST USE 5-17-2001; IN COMMERCE 5-17-2001.

FOR: COMPUTER GAME PROGRAMS; COMPU-
TER GAME SOFTWARE; VIDEO GAME MACHINE
ACCESSORIES, NAMELY, CARRY CASES; AND

SN 75-981,744, FILED 9-2-1999.

KIMBERLY PERRY, EXAMINING ATTORNEY

EXHIBIT B

Int. Cl.: 28

Prior U.S. Cls.: 22, 23, 38 and 50

Reg. No. 2,665,095

United States Patent and Trademark Office

Registered Dec. 24, 2002

**TRADEMARK
PRINCIPAL REGISTER**

GAME BOY ADVANCE

NINTENDO OF AMERICA INC. (WASHINGTON
CORPORATION)
4820-150TH N.E.
REDMOND, WA 98052

FOR: HAND-HELD UNITS FOR PLAYING VIDEO
GAMES; CONNECTORS TO CONNECT HAND-
HELD VIDEO GAME UNITS WITH OTHER VIDEO
GAME MACHINES, AND CARRY CASES FOR
CARRYING HAND-HELD UNITS FOR PLAYING

VIDEO GAMES, IN CLASS 28 (U.S. CLS. 22, 23, 38
AND 50).

FIRST USE 5-17-2001; IN COMMERCE 5-17-2001.

SER. NO. 75-982,105, FILED 9-2-1999.

KIMBERLY PERRY, EXAMINING ATTORNEY